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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,869	11/14/2003	Tai-Shung Neal Chung	6565-67326/RJP	1873
24197	7590	09/20/2004	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			BOYKIN, TERRESSA M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,869	Applicant(s) CHUNG ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the defined method for treating a polyimide via a low temperature crosslinking method appear to be the basis of the claimed invention as set forth in the specification, are not, however, set forth in applicants' claim 1. First, the specification on page 2 lines 3-4 specifically discloses that a low temperature crosslinking method is necessary. Secondly, the specification on page 3 further illustrates the method of treating said polyimide wherein "said compound being dissolved in a solvent under condition whereby said compound crosslinks said membrane." Moreover, applicants' dependent claims 6 and 16 reverberate the necessity of these limitations. For example, in claim 16, these "conditions" are understood by the examiner in reading the specification as meaning "low temperature" conditions. Such is not commensurate in scope with these claims. It is noted the CCPA has criticized the use of the characterization "too broad" or "undue breadth"....however, an application whose claim(s) are of a breadth which are not adequately supported by its specification is in violation of 35 USC 112, first paragraph. In re Borkowski et al., (CCPA 1970) 424 F2d 904; In re Wakefield, (CCPA 1970 422 F2d 897; In re Hammack, (CCPA 197).

Claim Rejections - 35 USC § 112

I. Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claim 1 which recites a method for "treating a polyimide...." via "exposing..." is indefinite with regard to the particular method and parameters of treating therein. Note that a method should at least recite clear, active steps and any process parameters necessitated by the specification so that the claim will "clearly set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Moore, 169 USPQ 236, and make it clear what subject matter the claim encompasses, as well as make clear the subject matter from others would be precluded. In re Hammack 166 USPQ 204. In the instant case, the low temperature crosslinking clearly disclosed in the specification have not been claimed in applicants' claim 1. See 112 first paragraph rejection above.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are

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available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Terressa Boykin, via the receptionist whose telephone number is (703) 308-2351. The examiner can normally be reached on Monday through Friday from 8:00a.m.-5:30 p.m.

tmb

A handwritten signature in black ink, reading "Terressa Boykin". The signature is written in a cursive, flowing style.

Examiner Terressa Boykin
Primary Examiner
Art Unit 1711